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09/931,844	08/16/2001	Joerg Heilig	P5210 US	4555
24209 7590 02/26/2008 GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940				
EXAMINER DUONG, THOMAS				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/931,844

**Applicant(s)**

HEILIG ET AL.

**Examiner**

THOMAS DUONG

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 23-38 and 40-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicants' election with traverse of *claims 1-22 and 39* in the reply filed on November 16, 2007 is acknowledged. The traversal is on the ground(s) that:

*"Thus, the Office over a three year period has issued six actions that considered all claims and that included five different grounds of rejection for all the claims.*

*Applicants have distinguished all five of the different rejections for all the claims, Claims 1 to 52.*

*Further, the Office has consistently taken the position, as demonstrated above, that Claims 1 to 52 have a unity of invention. Specifically, the same rejection has been used for claims that the Office now asserts are distinct inventions.*

*The instant action means that the Office has wasted three years of prosecution and now wants to start over.*

*Rather astoundingly, the Office now takes the position that the Office's consideration of the claims over the past three years and six examinations was in error and the claims now recite distinct inventions even though the claims are the same as those previously considered. The current action completely contradicts the prior characterizations and interpretation of the claims by the Office as having unity of invention, which in fact was correct."*

This is not found persuasive because the previous actions are made by Kevin Lin, who is no longer with the Office. The current examiner finds that the restriction is proper

because of the distinct inventions as presented in the Requirement for Election/Restriction dated October 15, 2007.

The requirement is still deemed proper and is therefore made FINAL. In response to this office action, cancellation of nonelected claims is required from the applicant.

***Priority***

2. Acknowledgment is made of Applicants' claim for foreign priority based on an application filed in European Patent Office (EPO) on August 18, 2000. It is noted, however, that Applicant has not filed a certified copy of the 00117311.1 application as required by 35 U.S.C. 119(b). Please submit a certified copy of the 00117311.1 application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 39 is rejected under 35 USC § 101 because the claims are not limited to tangible embodiments since they do not claim physical articles or objects as part of the claims to establish a statutory category as a machine or manufacture, and they are clearly not to a process or composition of matter. As claimed, an "A computer program product comprising a medium configured to store or transport computer readable code for a method comprising" fails to fall within a statutory category of invention; because, referring to the Specification, "A computer readable medium can be a magnetic or optical or other tangible medium on which a program is recorded, but can also be a signal, e.g.,

Art Unit: 2145

analog or digital, electromagnetic or optical, in which the program is embodied for transmission" (Specification, para.77). As such, the above claims are not limited to statutory subject matter and are, therefore, non-statutory. Hence, in order to overcome this 35 USC § 101 rejection, the above claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-22 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Rohrabach et al. (US 20020091738A1).

7. With regard to claims 1, 10, and 39, Rohrabach discloses,
- *a proxy server having a code section including instructions for receiving a request for data from a client, and making a determination whether the requested data should be rendered before transmission to the client; and* (Rohrabach, para.1-108)

Rohrbaugh discloses, *"With reference to the flowchart of FIG. 2A, the foregoing process is initiated by a client in a block 100, wherein the client submits a request to proxy server 32 to retrieve and convert selected content"* (Rohrbaugh, para.51). Hence, Rohrbaugh teaches of the client submitting a request to proxy server 32 (i.e., Applicants' proxy server receiving a request for data from client). Rohrbaugh discloses, *"The logic implemented by the invention when providing content to a client using infrastructure 10B is illustrated in the flowchart of FIG. 2B, wherein the process begins in a block 101 in which the client sends a content request 39 directly to the network site (e.g., web server 26), as depicted by a transfer path 41. In a block 103, HTTP negotiations are performed to determine the format the content is to be delivered in. For example, the request may contain indicia identifying the type of content requested, such as an SVF MIME type (e.g., image/vnd.svf). This is to inform the web server that the request is for specially-formatted content rather than conventional content. The server first checks to see if it already has cached the requested content. If it has, it sends the content to the requesting client; otherwise, it retrieves the parent HTML document in a block 107. It then performs processing steps in blocks 107, 109, and 111 to retrieve content referenced through embedded tags in a manner substantially similar to that discussed above with reference to respective blocks 106, 108, and 110. The primary difference in this instance is that the web server does not receive requests from or send documents to a proxy server--rather, the content is retrieved and processed at the web server, wherein the retrieved content may be stored local to the web server or retrieved from a remote server in a manner similar to that described above"* (Rohrbaugh, para.63). Hence,

Rohrbaugh teaches of the server (i.e., Applicants' proxy server) determining (i.e., Applicants' making a determination) the format the content (i.e., Applicants' requested data should be rendered) is to be delivered in (i.e., Applicants' transmission to the client).

- *a processing server coupled to the proxy server and having a code section including instructions for receiving the rendering determination from the proxy server, rendering the requested data, and transmitting the rendered data to the client.* (Rohrbaugh, para.1-108)

Rohrbaugh discloses, *"The logic implemented by the invention when providing content to a client using infrastructure 10B is illustrated in the flowchart of FIG. 2B, wherein the process begins in a block 101 in which the client sends a content request 39 directly to the network site (e.g., web server 26), as depicted by a transfer path 41. In a block 103, HTTP negotiations are performed to determine the format the content is to be delivered in. For example, the request may contain indicia identifying the type of content requested, such as an SVF MIME type (e.g., image/vnd.svf). This is to inform the web server that the request is for specially-formatted content rather than conventional content. The server first checks to see if it already has cached the requested content. If it has, it sends the content to the requesting client; otherwise, it retrieves the parent HTML document in a block 107. It then performs processing steps in blocks 107, 109, and 111 to retrieve content referenced through embedded tags in a manner substantially similar to that discussed above with reference to respective blocks 106, 108, and 110. The primary difference in this instance is that the web server does not receive requests from or send documents to a proxy server--rather, the*

*content is retrieved and processed at the web server, wherein the retrieved content may be stored local to the web server or retrieved from a remote server in a manner similar to that described above"* (Rohrbaugh, para.63). Hence, Rohrbaugh teaches of the web server (i.e., Applicants' processing server) being informed (i.e., Applicants' receiving the rendering determination) that the request is for specially formatted content. Rohrbaugh discloses, *"As before, the retrieved HTML documents are translated into scalable vector representations by HTML translator 58 in a block 114, while the graphic images are translated into a compressed bitmap format by image translator 60 in a block 116, as depicted by vectorized content 62 and bitmap content 64. The vectorized content and bitmap content are then streamed from the web server to the client in a block 119, as depicted by a transfer path 67. Upon arriving at the client, the vectorized content and bitmap content are processed, scaled, and rendered on the client in a block 120"* (Rohrbaugh, para.64). Hence, Rohrbaugh teaches of the web server (i.e., Applicants' processing server) translating (i.e., Applicants' rendering) the retrieved HTML documents (i.e., Applicants' requested data) into scalable vector representations of compressed bitmaps and then streamed (i.e., Applicants' transmitting) from the web server (i.e., Applicants' processing server) to the client.

8. With regard to claims 2 and 11, Rohrbaugh discloses,

- *wherein the proxy server further comprises a code section including instructions for storing the requested data in an intermediate data store if it is determined that*



*the requested data should be rendered before transmission to the client; and*  
(Rohrbaugh, para.1-108)

Rohrbaugh discloses, *"The server first checks to see if it already has cached the requested content. If it has, it sends the content to the requesting client; otherwise, it retrieves the parent HTML document in a block 107. It then performs processing steps in blocks 107, 109, and 111 to retrieve content referenced through embedded tags in a manner substantially similar to that discussed above with reference to respective blocks 106, 108, and 110. The primary difference in this instance is that the web server does not receive requests from or send documents to a proxy server—rather, the content is retrieved and processed at the web server, wherein the retrieved content may be stored local to the web server or retrieved from a remote server in a manner similar to that described above"* (Rohrbaugh, para.63). Hence, Rohrbaugh teaches of the server (i.e., Applicants' proxy server) retrieving (e.g. storing in a local storage space, implied) (i.e., Applicants' an intermediate data store) content referenced through embedded tags from appropriate servers.

- *the processing server further comprises a code section including instructions for retrieving data stored in the intermediate data store.* (Rohrbaugh, para.1-108)

9. With regard to claims 3 and 12, Rohrbaugh discloses,

- *wherein the proxy server includes a code section including instructions for transmitting address information to the processing server, wherein the address information corresponds to the storage location of the requested data at a data server; and* (Rohrbaugh, para.1-108)

Rohrbaugh discloses, *"The server first checks to see if it already has cached the requested content. If it has, it sends the content to the requesting client; otherwise, it retrieves the parent HTML document in a block 107. It then performs processing steps in blocks 107, 109, and 111 to retrieve content referenced through embedded tags in a manner substantially similar to that discussed above with reference to respective blocks 106, 108, and 110. The primary difference in this instance is that the web server does not receive requests from or send documents to a proxy server--rather, the content is retrieved and processed at the web server, wherein the retrieved content may be stored local to the web server or retrieved from a remote server in a manner similar to that described above"* (Rohrbaugh, para.63). Hence, Rohrbaugh teaches of the server (i.e., Applicants' proxy server) retrieving (e.g. storing in a local storage space, implied) (i.e., Applicants' an intermediate data store) content referenced through embedded tags from appropriate servers.

- *the processing server includes a code section containing instructions for retrieving the requested data from the data server.* (Rohrbaugh, para.1-108)

10. With regard to claims 4 and 13-14, Rohrbaugh discloses,

- *wherein the proxy server further comprises: a code section containing instructions for generating a link message containing address information corresponding to the requested data; and a code section containing instructions for transmitting the link message to the client.* (Rohrbaugh, para.1-108)
- Rohrbaugh discloses, *"The vectorized content and bitmap content are then streamed from the web server to the client in a block 119, as depicted by a*

*transfer path 67. Upon arriving at the client, the vectorized content and bitmap content are processed, scaled, and rendered on the client in a block 120"*  
(Rohrabaugh, para.64)

11. With regard to claims 5-7 and 15-18, Rohrabaugh discloses,

- *wherein the link message further includes data type information describing the requested data.* (Rohrabaugh, para.1-108)

Rohrabaugh discloses, *"The logic implemented by the invention when providing content to a client using infrastructure 10B is illustrated in the flowchart of FIG. 2B, wherein the process begins in a block 101 in which the client sends a content request 39 directly to the network site (e.g., web server 26), as depicted by a transfer path 41. In a block 103, HTTP negotiations are performed to determine the format the content is to be delivered in. For example, the request may contain indicia identifying the type of content requested, such as an SVF MIME type (e.g., image/vnd.svf). This is to inform the web server that the request is for specially-formatted content rather than conventional content. The server first checks to see if it already has cached the requested content. If it has, it sends the content to the requesting client; otherwise, it retrieves the parent HTML document in a block 107. It then performs processing steps in blocks 107, 109, and 111 to retrieve content referenced through embedded tags in a manner substantially similar to that discussed above with reference to respective blocks 106, 108, and 110. The primary difference in this instance is that the web server does not receive requests from or send documents to a proxy server--rather, the content is retrieved and processed at the web server, wherein the retrieved*

*content may be stored local to the web server or retrieved from a remote server in a manner similar to that described above” (Rohrbaugh, para.63)*

- *wherein the link message further includes a client identifier and a session identifier. (Rohrbaugh, para.1-108)*
- *wherein the address information of the requested data comprises a URL and the data type information comprises a MIME type. (Rohrbaugh, para.1-108)*

12. With regard to claims 8-9 and 19-20, Rohrbaugh discloses,

- *wherein the client further comprises a data handler including a code section containing instructions for establishing a communication link between the client and the processing server and for receiving the rendered data from the processing server. (Rohrbaugh, para.1-108)*
- *wherein the proxy server includes a code section containing instructions for directly transmitting the requested data to the client upon the proxy server determining that the requested data do not have to be rendered before transmission to the client. (Rohrbaugh, para.1-108)*

13. With regard to claims 21-22, Rohrbaugh discloses,

- *comprising pre-selecting requests for data into a first category comprising requests wherein the requested data should be rendered, and a second category wherein the requested data should not be rendered; (Rohrbaugh, para.1-108)*
- *transmitting requests in the first category to the proxy server; and (Rohrbaugh, para.1-108)*

Art Unit: 2145

- *transmitting the requested data corresponding to requests in the second category directly to the client.* (Rohrbaugh, para.1-108)
- *wherein at least the proxy server, the processing server, and the intermediate data storage are connected on a local area network.* (Rohrbaugh, para.1-108)

**Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on 571/272-3933. The fax phone numbers for the organization where this application or proceeding is assigned are 571/273-8300 for regular communications and 571/273-8300 for After Final communications.

*Thomas Duong (AU2145)*

*February 28, 2008*

*/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145*